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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,062	02/16/2001	John W. Fisher JR.	TACT-001/01US	4766

7590 02/22/2005

Mr. John W. Fisher
Tactical Marketing Ventures, LLC
10385 Westmoor Drive, Suite 200
Westminster, CO 80021

EXAMINER

HECK, MICHAEL C

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

MAR 08 2005

GROUP 3600

Office Action Summary

Application No.

09/785,062

Applicant(s)

FISHER ET AL.

Examiner

Michael C. Heck

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/16/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a First Office Action in response to the application filed 16 February 2001. Claims 1-21 are pending in this application and have been examined on the merits as discussed below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 370.

3. The drawings are objected to because on figure 3, step 335, the identified task is "Any Action in the Step Unassigned?". It should be -- Any Action Unassigned? --. Step 350 correctly references the "step".

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

- On page 16, Para 32, line 4, delete, "corresponding to that companies", and insert -- corresponding to ***the campaign*** --.
- On page 16, Para 32, line 5, delete, "(Step 302,310,315)", and insert -- (Step **305**,310,315) --.

The above citation is a mere guide. Applicant is requested to review the specification thoroughly to eliminate additional errors. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 and 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, **claims 1, 9 and 19** only recite an abstract idea. As to **claim 1**, the recited steps of defining a tier object representing a relationship between the enterprise and a target group; defining a target object associated with the tier object, wherein the target object is associated with a target group; defining a campaign object, wherein the campaign object is associated with an objective of the marketing activity; defining a program object, wherein the program object is associated with the campaign object and wherein the program object corresponds to an objective of the campaign object; defining a tactic object, wherein the tactic object is dependent upon the first program object; and generating the market model using the tier object, the target object, the campaign object, the program object and the tactic object does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for generating a market model for a marketing activity associated with an enterprise, therefore, is deemed to be directed to non-statutory subject matter. As to **claim 9**, the recited steps of defining a tier object representing a relationship between the enterprise

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and a target group; defining a target object associated with the tier object, wherein the target object is associated with a target group; defining a tactic object, wherein the tactic object is associated with the target object; and generating the market model using the tier object, the target object, and the tactic object does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The method only constitutes an idea for generating a market model for a marketing activity associated with an enterprise, therefore, is deemed to be directed to non-statutory subject matter. As to **claim 19**, the model of a tier object representing a relationship between the enterprise and a target group; a target object associated with the tier object, wherein the target object is associated with a target group; a campaign object, wherein the campaign object is associated with an objective of the marketing activity; a program object, wherein the program object is associated with the campaign object and wherein the program object corresponds to the objective of the campaign object; and a tactic object, wherein the tactic object is dependent upon the first program object does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The model only constitutes an idea for managing a marketing activity associated with an enterprise, therefore, is deemed to be directed to non-statutory subject matter.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implications of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory

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subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a market model for a marketing activity associated with an enterprise (i.e., repeatable, useful and tangible).

Looking at the claims as a whole, nothing in the body of the claims recite any structure or functionality to suggest that a computer performs a task.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, the same rejection as stated above for claims 1, 9 and 19 applies to **claims 2-8, 10-13 and 20-21**.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. (U.S. Patent 4,591,983) in view of PR Newswire (PR Newswire, New Software for Better Marketing, PR Newswire Association, Inc., 19 November 1996 [DIALOG: file 16]). Bennett et al. disclose a method and system for generating, displaying, and manipulating a marketing model comprising:

- **[Claim 1]** defining a tier object representing a relationship between the enterprise and a target group (Abstract, Bennett et al. teach a knowledge system has a hierarchical knowledge base comprising a functional decomposition of a set of elements over a plurality of hierarchical levels. The examiner interprets the elements to be within an enterprise.);

Bennett et al. fail to teach a target group, defining a target object associated with the tier object, wherein the target object is associated with a target group; defining a campaign object, wherein the campaign object is associated with an objective of the marketing activity; defining a program object, wherein the program object is associated with the campaign object and wherein the program object corresponds to an objective of the campaign object; defining a tactic object, wherein the tactic object is dependent upon the first program object; and generating the market model using the tier object, the target object, the campaign object, the program object and the tactic object. PR Newswire teaches Marketing Plus includes tools for developing detailed sales forecasts, expense budgets, strategic focus and target market focus. It helps users analyze the marketplace, plan advertising and public expenditures, manage tasks, track results, control expenses, and more. Marketing Plus utilizes visual frameworks like Palo Alto Software's proprietary Strategy Pyramid, which conceptually links strategy, tactics, and programs to assure strategic alignment. After the plan is developed, Marketing Plus

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continues to be useful. Its at-a-glance tracking and evaluation offers sorting of data by user-definable factors such as manager in charge, markets; types; product; programs; starting date or ending date; price, units or dollars total; and monthly or one-year periods (Para 4-6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the marketing plus software of PR Newswire with Bennett et al. since Bennett et al. teach a hierarchical knowledge base (abstract). Having an integrated management capability allows management to focus on planning than communication. Marketing Plus 2.0 is marketing management software for planning and implementing marketing strategy and action that turns the plan into a real management tool (Para1-2). Bennett et al. teach providing an intelligible knowledge base representation for configuration strategies and actions (col. 3, lines 36-38). Therefore, an integrated management tool serves as a communication tool that allows management to focus on planning.

- **[Claim 2]** associating timing data with the tactic object (PR Newswire: Para 6, PR Newswire teaches that after the plan is developed, Marketing Plus continues to be useful. Its at-a-glance tracking and evaluation offers sorting of data by user-definable factors such as starting date or ending date.); and
- generating a timeline object based upon, at least, the timing data that is associated with the tactic object (PR Newswire: Para 6, PR Newswire teaches that after the plan is developed, Marketing Plus continues to be useful. Its at-a-glance tracking and evaluation offers sorting of data by user-definable factors such as starting date or ending date.).
- **[Claim 3]** defining a company object; and defining a connector object linking the company object and the target object (PR Newswire: Para 5, PR Newswire teaches Marketing Plus utilizes visual frameworks like Palo Alto Software's proprietary Strategy Pyramid, which conceptually links strategy, tactics, and programs to assure strategic alignment.).

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- **[Claim 4]** an organizational object (Bennett et al.: col. 3, lines 33-35, Bennett et al. teach an intelligible knowledge base representation of hierarchical assemblies and their functionality).
- **[Claim 5]** associating the connector object with the campaign object (PR Newswire: Para 4, PR Newswire teaches Marketing Plus includes tools for developing detailed sales forecasts, expense budgets, strategic focus and target market focus.).
- **[Claim 6]** defining an analysis object (PR Newswire: Para 4, PR Newswire teaches Marketing Plus includes tools for developing detailed sales forecasts, expense budgets, strategic focus and target market focus. It helps users analyze the marketplace, plan advertising and public expenditures, manage tasks, track results, control expenses, and more.).
- **[Claim 7]** wherein the analysis object comprises: a marketing operational reporting object (PR Newswire: Para 6, PR Newswire teaches that after the plan is developed, Marketing Plus continues to be useful. Its at-a-glance tracking and evaluation offers sorting of data by user-definable factors such as manager in charge, markets; types; product; programs; starting date or ending date; price, units or dollars total; and monthly or one-year periods.).
- **[Claim 8]** wherein the analysis object comprises: a marketing results reporting object (PR Newswire: Para 4, PR Newswire teaches Marketing Plus includes tools for developing detailed sales forecasts, expense budgets, strategic focus and target market focus. It helps users analyze the marketplace, plan advertising and public expenditures, manage tasks, track results, control expenses, and more.).

Claims 9-21 substantially recites the same limitations as that of claims 1-8 with the distinction of the recited method being a method, computer readable medium and model. Hence the same rejection for claims 1-8 as applied above applies to claims 9-21.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Heck whose telephone number is (703) 305-

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8215. The examiner can normally be reached Monday thru Friday between the hours of 8:00am - 4:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (703) 305-9643. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "**Box AF**"]

(703) 746-9419 [Informal/Draft communication, labeled "**PROPOSED**" or
"**DRAFT**"]

Hand delivered responses should be brought to 220 South 20th Street, Crystal
Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

mch
16 February 2005

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER
AU 3623

Please type a plus sign (+) inside this box →



PTO/SB/08A (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	[Not Assigned]
		Filing Date	February 16, 2001
		First Named Inventor	Fisher, John W. Jr.
		Group Art Unit	[Not Assigned]
		Examiner Name	[Not Assigned]
Sheet 1 of	Attorney Docket Number	TACT-001/01US	

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
<i>MEH</i>	P1	5,056,792		Helweg-Larsen et al.	10/15/1991	
<i>MEH</i>	P2	5,249,300		Bachman et al.	09/28/1993	
<i>MEH</i>	P3	5,303,170		Valko	04/12/1994	
<i>MEH</i>	P4	5,890,133		Ernst	03/30/1999	
<i>MEH</i>	P5	5,963,910		Ulwick	10/05/1999	
<i>MEH</i>	P6	6,023,572		Lautzenheiser et al.	02/08/2000	
<i>MEH</i>	P7	6,044,357		Garg	03/28/2000	
<i>MEH</i>	P8	6,067,537		O'Connor et al.	05/23/2000	
<i>MEH</i>	P9	6,078,893		Quimet et al.	06/20/2000	
<i>MEH</i>	P10	6,085,165		Ulwick	07/04/2000	
<i>MEH</i>	P11	6,088,676		White, Jr.	07/11/2000	
<i>MEH</i>	P12	6,094,641		Quimet et al.	07/25/2000	
<i>MEH</i>	P13	6,115,691		Ulwick	09/02/2000	

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁴
		Office ³	Number ⁴	Kind Code ⁵ (if known)				

Examiner Signature	<i>Michael C. Heck</i>	Date Considered	2-16-05
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number.

² See attached Kinds of U.S. Patent Documents.

³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3).

⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible.

⁶ Applicant is to place a check mark here if English language Translation is attached.

Notice of References Cited	Application/Control No. 09/785,062	Applicant(s)/Patent Under Reexamination FISHER ET AL.	
	Examiner Michael C. Heck	Art Unit 3623	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-4,591,983	05-1986	Bennett et al.	706/53
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	PR Newswire, New Software for Better Marketing, PR Newswire Association, Inc., 19 November 1996 [DIALOG: file 16]
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

5/9/2 (Item 1 from file: 16)
DIALOG(R) File 16:Gale Group PROMT(R)
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04691292 Supplier Number: 46904918 (THIS IS THE FULLTEXT)

New Software for Better Marketing

PR Newswire, pl119SFTU043

Nov 19, 1996

Language: English Record Type: Fulltext

Document Type: Newswire; Trade

Word Count: 439

TEXT:

EUGENE, Ore., Nov. 19 /PRNewswire/ -- **Marketing Plus 2.0, Palo Alto Software** 's new marketing management software, is the only complete, all-in-one program for planning and implementing marketing strategy and action.

Marketing Plus walks the user through development of a strategic marketing plan. Unlike other marketing plan software, it is also designed for day-to-day follow-up on the plan. It tracks results, deadlines and responsibilities, turning the plan into a real management tool. Perhaps best of all, **Marketing Plus** is user-friendly.

The software is designed for professional marketing managers, entrepreneurs, and everyone else who needs to write a marketing plan but has no time to wonder how to do it.

Marketing Plus 2.0 debuted in November 1996.

Marketing Plus includes tools for developing detailed sales forecasts, expense budgets, strategic focus and target market focus. It helps users analyze the marketplace, plan advertising and public relations expenditures, manage tasks, track results, control expenses and more.

Marketing Plus utilizes visual frameworks like **Palo Alto Software** 's proprietary Strategy Pyramid, which conceptually links strategy, tactics and programs to assure strategic alignment. The planner chooses among hundreds of built-in, customizable, charts and uses powerful spreadsheets for forecasts, budgets and tracking. The information automatically merges and prints out as a beautifully formatted, complete plan.

After the plan is developed, **Marketing Plus** continues to be useful. Its at-a-glance tracking and evaluation offers sorting of data by user-definable factors such as manager in charge; markets; types; product; programs; starting date or ending date; price, units or dollar total; and monthly or one-year periods. This level of detail makes implementation of the plan a natural.

Marketing Plus 2.0 is a stand-alone Windows software applications. No additional software is needed. **Marketing Plus** requires Windows 3.1 or Windows 95, 4 MB RAM, 6 MB disk space and a mouse.

The software includes a marketing video from Inc. Magazine and excerpts from Jane Applegate's "Strategies for Small Business Success."

Marketing Plus 2.0's suggested retail price is \$164.95. The software is available in software outlets.

Palo Alto's other best-selling planning software is Business Plan Pro(TM); portions of **Marketing Plus** may be exported to Business Plan Pro for incorporation into a business plan.

More information is available on **Palo Alto Software** 's website, <http://www.palo-alto.com>, or by calling 800-229-7526.

SOURCE **Palo Alto Software**

-0-

11/19/96

/CONTACT: Marilyn Milne of Public Relations Services, 541-344-7989, or prpr@aol.com, for **Palo Alto Software** ; or Tim Berry of **Palo Alto Software** , 800-229-7526, or tim@pasware.com/

CO: **Palo Alto Software**

ST: Oregon

IN: CPR

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SM

-- SFTU043 --

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PRODUCT NAMES: *7372410 (Business Applications Software)

INDUSTRY NAMES: BUS (Business, General); BUSN (Any type of business)

NAICS CODES: 51121 (Software Publishers)

SPECIAL FEATURES: COMPANY

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